

REMARKS

This paper is in response to the Office Action mailed April 2, 2007. With this response non claims are amended. Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

I. Rejections Under 35 U.S.C. §101

In item 3 of the Office Action claims 1-43 were rejected under 35 U.S.C. §101. Specifically, the Examiner asserted that claims 1-43 were rejected as being directed to non-statutory subject matter. The Applicant respectfully disagrees.

35 U.S.C. §101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Thus, 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be appropriate subject matter of a patent: processes, machines, manufactures, and compositions of matter. The latter three categories define “things” or “products” while the first category defines “actions”. *See* 35 U.S.C. §100(b) (“The term ‘process’ means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”).

As the Supreme Court held, Congress chose the expansive language of 35 U.S.C. §101 so as to include “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). The Federal Circuit has embraced this perspective:

The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set for in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term “any” in section 101 represents Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35 ... Thus, it is improper to read into section 101 limitations as to the

subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations. *In re Alappat*, 33 F.3d 1526, 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994).

Accordingly, a complete definition of the scope of 35 U.S.C. §101, reflecting Congressional intent, is that any new and useful process, machine, manufacture, or composition of matter (or any new and useful improvement thereof) under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature, and natural phenomena. These three judicial exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature, or a natural phenomena is not patentable. *See, e.g., Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) (“While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.”). The courts have held that a claim may not preempt ideas, laws of nature, or natural phenomena. Accordingly, one may not patent every “substantial practical application” of an idea, law of nature, or natural phenomena because such a patent “in practical effect be a patent on the [idea, law of nature or natural phenomena] itself.” *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

To determine if an exception is eligible for a patent, a physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.” *AT&T*, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If the Examiner determines that the claim does not entail the transformation of an article, then the Examiner shall review the claim to determine if it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is “useful, tangible, and concrete.”

In determining whether a claim provides a useful, tangible, and concrete result, the Examiner should consider and weigh the following factors: For an invention to be "useful" it must satisfy the utility requirement of § 101. That is the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107. For an invention to be tangible, it does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. It simply must provide an application of the idea or law of nature. For an invention to be concrete, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)

Thus, in determining if a claim is directed to statutory subject matter the Examiner should follow a three step process. The first step is to determine if the claims are directed towards a new and useful process, machine, manufacture, or composition of matter. Second, once the Examiner has determined that the claims are directed towards statutory subject matter, the Examiner then must determine if the claims are directed towards a judicially created exception to statutory subject matter. Thus, the Examiner should determine if the claims are directed towards an abstract idea, a law of nature or a natural phenomena. Third, if the Examiner determines that the claims are directed towards an exception to patentability, the Examiner must still determine if the claims are directed towards an exception to the exception. That is the claim must produce a useful, tangible and concrete result. Only then can the Examiner determine that a claim is or is not statutory.

First, the Examiner has not provided a detailed analysis as to the reasoning that claims 1-43 are asserted as being directed to non-statutory subject matter. In the Office Action the Examiner has simply skipped the entire process and determined that because the specification discusses computer implementations, the claims are therefore directed to non statutory subject matter. Thus, the Applicant asserts that the Examiner has failed to provide on the record a prima facie case that the claims are directed to non-statutory subject matter as required in M.P.E.P §2106 (IV)(D).

Turning now to the claims. Claims 1-12 and 30-43 are directed to a system for providing protection against malicious code. The claims are directed to a system, which is statutory subject matter. The Examiner has not stated what abstract idea, law of nature or natural phenomena the claims encompass. Therefore, the Examiner has failed to make a prima facie case that claims 1-12 and 30-43 are directed to an exception to a judicially created exception to statutory subject matter. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 20-29 are directed to a method for providing protection against malicious code. The claims are directed to a method, which is statutory subject matter. The Examiner has not stated what abstract idea, law of nature or natural phenomena the claims encompass. Therefore, the Examiner has failed to make a prima facie case that claims 20-29 are directed to an exception to a judicially created exception to statutory subject matter. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 13-19 are directed to a computer program product. The Examiner asserted that these claims were not statutory. Further, the Examiner rejects claims 13-19 under the rationale that the claims can cover an embodiment wherein the recited "computer readable medium" is a carrier wave or signal. Specifically, the Examiner asserts that such embodiments do not fall under any of the statutory categories of eligible subject matter (new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof) because carrier waves and signals are "intangible media." However, the Examiner does not provide an explanation as to where this assumption is derived. Claims 13-19 are directed to "computer readable medium" which is statutory subject matter. Therefore, it is respectfully submitted that the Examiner has failed to make a prima facie case that claims 13-19 are directed to non-statutory subject matter. Reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejections under 35 U.S.C. §102

In item 6 of the Office Action the Examiner rejected claims 1, 3, 8-11, 13, 14, 16-22, 26-34 and 40-43 under 35 U.S.C. §102(e) as being anticipated by Muttik, U.S. Patent No 6,775,780, hereinafter "Muttik." The Applicant respectfully disagrees.

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). The Applicant respectfully asserts that the rejection does not satisfy these requirements.

Claim 1 recites "a malicious code analyzer disposed in a communication system traffic pattern between an originator of an information communication of said communication system traffic pattern and an intended recipient... said malicious code analyzer being configured to be transparent to systems of said communication system." The Examiner asserted that Fig 2, element 108 and column 1 line 65 to column 2 line 11 disclosed all of the features of claim 1. It appears that the Examiner relies upon the emulator of Muttik to teach the claimed malicious code analyzer. Without admitting that such characterization is correct it is noted that Muttik does not disclose the location of the emulator in the communications systems traffic pattern. This fact in and of itself negating any assertion of anticipation. Further, from the disclosure, it appears as though the emulator is not disposed between the originator and the intended recipient, but is isolated from the communications stream. In other words, it appears from the disclosure of Muttik that the emulator does not pass the code out following the to an intended recipient. In fact it appears from the disclosure of Muttik that the only thing that is passed from the emulator is the result of the analysis for the user to know if good or bad code was detected. Therefore, it is respectfully asserted that Muttik does not disclose this feature of the claim.

Further, Muttik does not disclose the emulator being transparent to systems of said communications systems. From the disclosure of Muttik, it appears as if the emulator is visible to at least part of the communications system in that it provides an output if a malicious code is found or not found depending on the configuration. Therefore, it is respectfully asserted that Muttik does not disclose this feature of the claim. Thus, claim 1 is believed allowable over Muttik. Furthermore, dependent claims 3, and 8-11 are believed allowable as well at least by virtue of their dependency from claim 1. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 8 recites “wherein said malicious code analyzer comprises: code for virus scanning.” Further the Examiner asserted that claims 16 and 26 have similar limitations. The Examiner asserted that this was disclosed on column 3 lines 55-56 of Muttik. However, the cited section only discloses analyzing code in order to detect malicious behavior. Muttik only looks for malicious behavior in the code but it is not taught to specifically scan for viruses. Thus, Muttik does not disclose all of the elements of claim 8. Therefore it is respectfully submitted that claim 8 is allowable. Furthermore, claims 16 and 26 are believed allowable for similar reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 9 recited “wherein said malicious code analyzer comprises: code for identifying unwanted or unsolicited messages.” Further the Examiner asserted that claims 17 and 27 have similar limitations. The Examiner asserted that this was disclosed in column 3 lines 49-52. The cited section only discloses that the emulator analyzes the code to determine a pattern of calls to identify potentially malicious behavior. However, the section does not teach analyzing the code or identifying unwanted or unsolicited messages. Thus, Muttik does not disclose all of the elements of claim 9. Therefore, it is respectfully submitted that claim 9 is allowable. Furthermore, claims 17 and 27 are believed allowable as well for at least similar reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 10 recites “a steering module for said information communication between a first interface and a second interface of said system....” The Examiner asserted that claim 10 has similar limitations as claim 3, and is therefore rejected for similar reasons. However, claim 3

does not require a steering module nor does claim 3 require the direction of at least some of the information communication to the malicious code analyzer. Therefore, the Examiner's assertion that the claims contain similar limitations is incorrect. Further, the sections of Muttik cited in the rejection of claim 3, and asserted as being relevant to claim 10, do not disclose a steering module between a first and a second interface of the system. Should the Office persist in this rejection, clarification is respectfully requested. Therefore, it is respectfully submitted that Muttik does not disclose all of the features of claim 10. Therefore, claim 10 is believed allowable over Muttik. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 11 recites "communications throttle for determining if said information communication is to be passed by said system." Further the Examiner asserted that claim 29 has similar limitations. The Examiner asserted that Muttik disclosed this feature at column 4 lines 8-11. However, the cited section only discloses that the user is alerted of the decision that can indicate if the code exhibits or does not exhibit malicious behavior. The cited section does not disclose if the associated code is to be passed to the system, nor does it disclose a communications throttle for determining this. Thus, Muttik does not disclose the features of claim 11. Therefore, claim 11 is believed allowable over Muttik. Furthermore, claim 29 is believed allowable as well for at least similar reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

In item 6g claim 13 was rejected for reasons similar for the rejection of claims 1 and 10. See office action page 4. As discussed above, the Applicant asserts that Muttik does not disclose the features of claims 1-10. Therefore similar rejections claim 13 is believed allowable as well. Further claim 14 is believed allowable as well, at least, by virtue of its dependency from claim 13. Reconsideration and withdrawal of the rejection are respectfully requested.

Independent claim 20 recites "analyzing said at least a portion of said packets by said malicious code analyzer before releasing said at least a portion of said packets back into said traffic pattern." The Examiner asserted this feature was disclosed in Muttik at column 3 lines 54-57. However, the cited section of Muttik does not disclose releasing anything, let alone a

portion of packets back into the traffic pattern. Should the Office persist in this rejection, clarification is respectfully requested. Thus, Muttik does not disclose all of the features of claim 20. Therefore, claim 20 is believed allowable. Further claims 21, 22, and 29 are believed allowable as well, at least, by virtue of its dependency from claim 20. Reconsideration and withdrawal of the rejection are respectfully requested.

In item 6n the Examiner indicated that claim 21 has limitations that are similar to those of claim 20 and it is rejected with the same rationale applied against claim 20 above. See Office Action page 5. However, claim 21 depends from claim 20 and by definition includes additional limitations. The Examiner has failed to examine these additional limitations as no reference in the Muttik reference is provided. Thus, the Applicant asserts that the Examiner has failed to make a prima facie case of anticipation. Should the Office persist in the rejection, a new non-final Office Action should be sent that specifically describes the rejection of claim 21 so that the Applicant has a full and fair opportunity to respond. Further claim 21 is believed allowable by virtue of its dependency from claim 20. Reconsideration and withdrawal of the rejection are respectfully requested.

In item 6q the Examiner rejected claim 30 and asserted that this claim has features substantially similar to the features of claims 1, 3 and 10 and is rejected for similar reasons as the rejection of those claims. As discussed above, the cited sections of Muttik do not disclose the features of claims 1, 3 and 10. At least for similar reasons the Applicant asserts that the features of claim 30 are not disclosed by Muttik. Therefore, claim 30 is believed to be allowable over Muttik. Reconsideration and withdrawal of the rejection are respectfully requested.

In item 6q the Examiner rejected claims 31-34 and 40-43. The Examiner asserted that these claims have limitations that are similar to those of claims 20-22 and 26-29 and are rejected for the same reasons. As discussed above, the Applicant asserts that claims 20-22 and 26-29 are believed allowable over Muttik. Therefore, for similar reasons claims 31-34 and 40-43 are believed allowable over Muttik. Reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejections Under 35 U.S.C. §103

In item 8 of the Office Action the Examiner rejected claims 2, 4-7, 12, 15, 23-25, and 35-39 under 35 U.S.C. §103(a) as being unpatentable over Muttik in view of Mathon et al, U.S. Patent No. 7,032,005 B2, hereinafter “Mathon.” The Applicant has reviewed the cited portions of the references and must respectfully disagree.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the Examiner must consider the four Graham factual inquiries. Further, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, that one could modify the reference or to combine reference teachings. Further, it is “important to identify a reason that would have prompted a person of ordinary skill... to have combined the [prior art] elements in the way that the claimed invention does.” *KSR Int’l Co. v. Teleflex, Inc.*, No. 05-1350, 550 U.S. _____ (2007). Second, there must be a reasonable expectation of success (i.e. the results of the combination are predictable). See M.P.E.P. § 2131. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143.03. The Applicant respectfully asserts that the rejection does not satisfy the basic criteria.

Claims 2, 4-7, 12, 15, 23-25 and 35-39 are dependent claims and depend either directly or indirectly from independent claims 1, 13, 20, and 30 respectively, and therefore inherit the limitations of the base claim and any intervening claims. For the reasons discussed above with respect to the independent claims the Applicant asserts that Muttik does not disclose the features of those claims in their entirety. The addition of Mathon does not remedy the identified deficiencies, nor has the Examiner provided an assertion by person that this is the case. Thus, the applicant asserts that the combination of Muttik and Mathon fails to teach or suggest all elements of the dependent claims in their entirety. Therefore, claims 2, 4-7, 12, 15, 23-25 and 35-39 are believed allowable over the combination of Muttik and Mathon. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the above, applicant believes the pending application is in condition for allowance. Reconsideration and allowance of the pending claims are respectfully requested.

Applicant believes an extension of time fee of \$510.00 is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 06-2380, under Order No. 58895/P003US/10305848 from which the undersigned is authorized to draw.

Dated: October 2, 2007

Respectfully submitted,

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